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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,917	05/28/2002	Gerhard Heise	SI01-011	2793
21971	7590	06/03/2004		
WILSON SONSINI GOODRICH & ROSATI 650 PAGE MILL ROAD PALO ALTO, CA 943041050				
			EXAMINER PAK, SUNG H	
			ART UNIT 2874	PAPER NUMBER

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,917

Applicant(s)

HEISE ET AL.

Examiner

Sung H. Pak

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2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-14 is/are allowed.
- 6) ☒ Claim(s) 1,2,7,8 and 15 is/are rejected.
- 7) ☒ Claim(s) 3-6 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0404</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Applicant's amendment filed 3/15/2004 has been entered. Claims 1-8, 11-16 are now pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-2, 7-8, 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Albrecht et al (US 6,470,119 B1) as discussed in the prior office action.

Albrecht et al reference discloses an optical device with all the limitations set forth in the claims, including: a first waveguide and a second waveguide (Fig. 1); variable-length element ("7" Fig. 1); which holds the first waveguide (Fig. 1), and the variable-length element being

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fixed via a first holding element (Fig. 1) to the structure containing the second waveguide; a guide element which permits the variable-length element to lengthen only in a spatial direction oriented substantially parallel to the longitudinal axis of the element (Fig. 3-4); wherein the guide has a second holding block as an abutment on which the variable-length element is guided parallel to its extension direction (Fig. 3-4).

Allowable Subject Matter

Claims 11-14 are allowed.

Claims 3-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

These claims recite allowable subject matter discussed in the prior office action.

Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: An optical coupling device for cross-coupling light from a first optical waveguide into a second waveguide is known in the art as discussed. However, none of the prior art fairly teaches or suggests such optical coupling device having a guide device which restrains a variable-length element from moving in either special directions along the first and second axis orthogonal to the longitudinal axis of the variable-length element, in which the guide device comprises an

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abutment fixed to the variable-length element and fixed to a waveguide holding structure with spring on one side and a setting screw on the other, as claimed in the instant application.

Response to Arguments

Claims 1-2, 7-8, 15:

On page 6 of the applicant's amendment, it is argued that Albrecht "provides rigid restraint along only one axis orthogonal to the longitudinal axis of [the] expansion element." And further it is argued that "the only restraint provided by [the] guide means along the other orthogonal axis is frictional, which is not rigid."

The examiner respectfully disagrees with the applicant's characterization of the Albrecht device. Figure 7 of Albrecht explicitly disclose an alternative embodiment of the device, wherein the guide device "100" is necessarily rigid. The 'rack and pinion' configuration of the variable-length element would not work if the guide device "100" is flexible, and also, the optical waveguides "3" and "5" would not be aligned properly if the guide device "100" is flexible. Therefore, figure 7 discloses the guide device providing restraint along "the other orthogonal axis" via frictional force AND a rigid element "100." Since the claimed limitations are taught by the reference, the claim rejection based on 35 USC 102 is proper.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

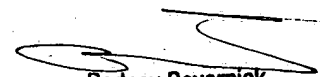
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sung H. Pak whose telephone number is (571) 272-2353. The examiner can normally be reached on Monday - Thursday : 6:30am- 5:00pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sung H. Pak
Examiner
Art Unit 2874



Rodney Bovernick
Supervisory Patent Examiner
Technology Center 2800